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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.	CONFIRMATION NO.
10/665,932	09/18/2003	Chris Kirmse	08226/1203348-US2	6591

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EXAMINER
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LIM, SENG HENG

ART UNIT	PAPER NUMBER
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3714

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/665,932	Applicant(s) KIRMSE ET AL.	
	Examiner SENG H. LIM	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/18/03, 1/13/06</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 38-51, 64-85, 96-105** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims fail to claim the logic and program recorded on an appropriate computer readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. No physical transformation takes place. If the result supports a disclosed specific, substantial and credible utility, claims would be useful. Claims merely recite a specific application of an abstract idea.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 8-9, 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Re claim 1. Danieli et al discloses a game and messenger client server system, comprising: a plurality of game clients (5:28-30); a game server including logic to

Art Unit: 3714

operate a multiplayer game using inputs from and outputs to an active game set of game clients including the plurality of game clients, wherein game clients other than those in the active game set can join an active game by supplying the game server with a reference to the active game (3:7-24); a plurality of messenger clients; a messenger server including logic to forward messages from a sender messenger client to a receiving messenger client; logic to couple a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game; and logic to initiate a join of a game at an invitee client, using data received in a message to the invitee (9:58-62; 3:10-4:10; Fig. 19, 9).

Re claim 8, 9. The system further comprising an icon that indicates a state of an inviter client, wherein the icon is a game-specific icon (7:32-40).

Re claim 10. The game and messenger client server system further comprising logic to generate a data file sent in response to a request from the invitee client (9:58-62).

**Claims 17-20, 23-24** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses a method of operating a multi-player game having a plurality of game clients and a plurality of messenger clients, the plurality of game clients and plurality of messenger clients in communication with a game server and a messenger server (Fig. 1), the method comprising: joining the game by sending a reference to the game to the game server; sending, from an inviter game client to an inviter messenger client, data used to initiate joining the game; sending a message including the data used to initiate joining the game to the messenger server; routing the message to an invitee messenger client; and using the data in the routed message to invoke a game client and join the game. The method includes sending, from the game server to the inviter game client, a reference used to join the game; sending the message to a list of messenger clients associated with the inviter messenger client, wherein an updated state is perceptible by a user of the invitee messenger client;

Art Unit: 3714

updating a state of an icon associated with the inviter messenger client in response to receiving the message; and sending a request for a game data file to the game server. The game data file includes a reference to the game locally (3:10-4:10).

**Claims 28-32** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses a method of operating a multi-player game having an inviter client, an invitee client, and a server, the method comprising: invoking an inviter game client at the inviter client; connecting the inviter game client to the game by sending a reference to the game to the server; creating a message at the inviter client containing data used for invoking an invitee game client and for joining the game; routing the message to the invitee client; and using the data in the message to invoke the invitee game client and join the game. Creating the message comprises of creating the message at the inviter client/server and routing the message by using TCP/IP (2:6-10). The message is sent to a second server (3:10-4:10).

**Claim 33** is rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses a game and messenger client server system, comprising: a plurality of game clients including an inviter and an invitee game client; a plurality of messenger clients including an inviter and invitee messenger client; a server including logic to operate a multiplayer game using inputs from and outputs to an active game set of game clients of the plurality of game clients, wherein game clients other than those in the active game set can join an active game by supplying the server with a reference to the active game (3:10-13, 10:43-48); logic to couple the inviter game client to the inviter messenger client to allow the inviter game client to send the inviter messenger client data used to initiate joining a game, whereby a message sent by the inviter messenger client includes the data used to initiate joining a game; and logic to initiate a join of a game at the invitee game client, using data received in a message to the invitee

messenger client, wherein the inviter messenger client includes logic to forward messages to the invitee messenger client (3:25-53).

**Claims 35-39** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses a program and method for providing a multi user networked computing environment, the method using an activity server and a messenger server, where the activity server and the messenger server are configured to communicate with a plurality of user computer systems, the user computer system including an activity client where the user computer system executes a user interface operated by a human user and is further configured to engage an activity using the activity client, wherein the user interface includes a display device and a user input device, wherein the user computer system is coupled to a network for exchanging information with the activity server and the messenger server (Fig. 1, 6), the method comprising: accepting signals from the user input device to engage the activity or game using the activity or game client; presenting one or more preferences to the user computer system, where the one or more preferences are associated with activities or games; selecting at least one preference to join the activity or game; invoking the selected activity with a messenger client; providing to the messenger server a user state and a reference to the activity or game in which the user is participating; and presenting to another user associated with at least one of the plurality of user computer systems the user state and the reference to the activity or game (3:10-53).

**Claims 40-51, 96-105** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses logic and computer program product for use at an invitee client to initiate joining by an invitee game client to an active game that is hosted by a game server and to which an inviter game client is joined, the invitee client including an invitee messenger client for receiving in at least one message from an inviter messenger client data used to initiate joining a game, the logic comprising: invocation

Art Unit: 3714

logic for using the data to invoke the invitee game client and connect the invitee game client to the game server, wherein the data includes a reference to the game server and a reference to the active game, the inviter and invitee game clients being respectively associated with the inviter and invitee messenger clients. The data used to initiate joining a game includes a game server network address that identifies the game server, a game identifier that identifies the active game on the identified game server, and a port identifier that identifies a port on the identified game server (3:10-13, 10:43-48). Danieli also discloses the logic for activating the invocation logic in response to action by a user (10:14-17); for displaying a buddy list of the invitee messenger client and an indication that the invitee game client may join an active game which a member of the buddy list is playing (Fig. 8); for displaying a game-specific icon identifying the active game (Fig. 19); for use at an invitee client wherein the invitee messenger client is associated with a member of a buddy list of the inviter messenger client (Fig. 18); for use at an invitee client wherein the invitee messenger and game clients reside at a first computer system, and the inviter messenger and game clients reside at a second computer system (Fig. 1, 8, 14); for sending to other messenger clients at least one message including a reference to an active game (3:10-13, 45-50); for use at an invitee client wherein the invitee messenger client is operable to receive the at least one message inherently via a messenger server and to read at least one registry entry usable to invoke the invitee game client; for use at an invitee client wherein the invitee messenger client is operable to receive at least one message including a reference to a potential game (3:10-13, 45-50).

**Claims 52-95** are rejected under 35 U.S.C. 102(e) as being anticipated by Danieli et al (US 7240093 B1).

Danieli et al discloses a logic with computer program product comprising program code and method of operating an invitee client to initiate joining by an invitee game client to an active game that is hosted by a game server and to which an inviter game client is joined, the invitee client including an invitee messenger client for receiving in at least one message from an inviter messenger client data used to initiate

Art Unit: 3714

joining a game, the method comprising: invoking the invitee game client using the data; and connecting the invitee game client to the game server using the data, wherein the data includes a reference or identifier such as an IP address to the game server and a reference to the active game, the inviter and invitee game clients being respectively associated with the inviter and invitee messenger clients. User initiates joining to the active game in response to action by a user (3:10-13, 45-50, 10:43-48). The method further comprising displaying a buddy list of the invitee messenger client and an indication that the invitee game client may join an active game which a member of the buddy list is playing (Fig. 8). The method further comprising displaying a game-specific icon identifying the active game (Fig. 19). The invitee messenger client is associated with a member of a buddy list of the inviter messenger client (Fig. 18). The invitee messenger and game clients reside at a first computer system, and the inviter messenger and game clients reside at a second computer system (Fig. 1). The method further comprising sending to other messenger clients at least one message including a reference to an active game (3:10-13, 45-50, 10:43-48).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).



Art Unit: 3714

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 17, & 33** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 13 of U.S. Patent No. 6699125 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method of operating a game and messenger client server system comprising of a plurality of game clients, a game server, plurality of messenger clients, a messenger server, and logic to couple game client to messenger client and initiate a join of a game at an invitee client.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached USPTO form PTO-892.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SENG H. LIM whose telephone number is (571)270-3301. The examiner can normally be reached on 8:30-6:00, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. H. L./

Examiner, Art Unit 3714

January 31, 2008



ROBERT E. PEZZUTO  
SUPERVISORY PRIMARY EXAMINER